

REMARKS

Claims 1-40 were originally pending in the application. Claims 1-14 were allowed. Therefore, claims 15-40 are currently pending in the application.

Claims 15 and 21 have been amended. The remaining claims are unchanged.

Claim 15 has been amended to recite “wherein said vinyl ester transesterification catalyst is incorporated into the polyester.” Support for this amendment can be found throughout the specification and claims, and specifically in the specification on page 1, lines 7-10, and in claim 1.

Claim 21 has been amended to correct a minor typographical error. Claim 21 inadvertently read “a method,” even though the claim is dependent upon claim 15, which is a composition. Claim 21 now reads “a composition.”

Reconsideration of the present application and allowance of the pending claims are respectfully requested in view of the following remarks.

The Office Action has maintained the rejection of claims 15-40 under 35 U.S.C. §102(e) as anticipated by U.S. Patent No. 6,709,746 issued to Wood *et al.* The Office Action states that “Applicants’ arguments are not persuasive with regard to the above claims in that the claims do not contain the limitations in which applicants are referring in the recent response.” The rejection based on the *Wood* patent is respectfully traversed in view of the following remarks.

As discussed in the previous response, Applicants’ invention is directed to a method for incorporating at least one active vinyl ester transesterification catalyst into a polyester. The polyester may already contain a polymerization catalyst used in forming the polyester (i.e. promotion of the ester linkages in polyester). Applicants’ vinyl ester transesterification catalyst is added to the polyester in addition to any polyester forming catalyst that may have been used to

initially form the polyester. The *Wood* reference does not teach the addition of a vinyl ester transesterification catalyst into a polyester.

With regards to Claims 15-23, Applicants note that claim 15, from which claims 16-23 depend, has been amended to recite “wherein said vinyl ester transesterification catalyst is incorporated into the polyester.” As discussed previously, the *Wood* reference does not teach the addition of a vinyl ester transesterification catalyst into a polyester. Thus, the *Wood* patent fails to teach each and every element of the presently claimed invention. Because *Wood* does not anticipate the compositions of claims 15-23, Applicants respectfully request withdrawal of this rejection.

With regard to claims 24-37, Applicants note that that claim 24, from which claims 25-37 depend, includes the step of “incorporating into polyester having vinyl ester end groups at least one active vinyl ester transesterification catalyst.” As discussed previously, the *Wood* reference does not teach the addition of a vinyl ester transesterification catalyst into a polyester. Thus, the *Wood* patent fails to teach each and every element of the presently claimed invention. Because *Wood* does not anticipate the methods of claims 24-37, Applicants respectfully request withdrawal of this rejection.

With regard to claims 38-40, Applicants note that that claim 38, from which claim 39 and 40 depend, includes the steps of “preparing a polyester melt” and “adding to the polyester melt a vinyl ester transesterification catalyst.” As discussed previously, the *Wood* reference does not teach the addition of a vinyl ester transesterification catalyst into a polyester. Thus, the *Wood* patent fails to teach each and every element of the presently claimed invention. Because *Wood* does not anticipate the methods of claims 38-40, Applicants respectfully request withdrawal of this rejection.

Not only does the *Wood* reference fail to anticipate the presently claimed invention, it also does not render the presently claimed invention obvious. To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See M.P.E.P. §2143. Furthermore, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must be both found in the prior art, not in Applicants' disclosure. See *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Importantly this evidence of teaching, suggestion, or motivation to combine must be "clear and particular." *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999).

In the present case, the *Wood* reference neither suggests nor motivates one of ordinary skilled in the art to arrive at the presently claimed invention. In particular, the *Wood* reference, as stated above, teaches the use of cyclodextrin which complexes and associates with metallic catalysts to prevent the production of acetaldehyde. (See abstract; col. 5 lines 54-59; col. 14, lines 36-40; col. 18, lines 12-30; col. 19, lines 36-41). On the other hand, Applicants' presently claimed invention promotes the formation of acetaldehyde by adding vinyl ester transesterification catalyst into a polyester which may already contain a polymerization catalyst. Thus, because of the different results, one of ordinary skilled in the art would not have been suggested or motivated to modify the teachings of the *Wood* reference to arrive at the presently claimed invention. Even if there were some remote motivation or suggestion to modify the *Wood* reference, there would have been no reasonable expectation of success. Applicants have

discovered that in polyester melts, most of the contained acetaldehyde is actually present as vinyl ester end groups, and to a lesser extent as methyl dioxolane, which can be converted to acetaldehyde and removed. Therefore, using any compound or compounds which inhibits the production of acetaldehyde, as taught by the *Wood* reference, would render the present invention useless. Because the *Wood* reference neither anticipates nor renders the presently claimed invention obvious, Applicants respectfully request withdrawal of this rejection.

In view of the present response to Office Action, Applicants respectfully request that a timely Notice of Allowance be issued in this case. If there are any issues which can be resolved by a telephone conference or an examiner's amendment, the Examiner is invited to telephone the attorney at (404) 853-8064.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Peter G. Pappas". The signature is fluid and cursive, with the first name "Peter" and last name "Pappas" clearly distinguishable.

Peter G. Pappas
Reg. No. 33,205

SUTHERLAND ASBILL & BRENNAN LLP
999 Peachtree Street, NE
Atlanta, Georgia 30309-3996
Telephone: (404) 853-8000
Facsimile: (404) 853-8806